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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/243,016 02/02/99 LENZ

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HM12/0703

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EXAMINER

GHALI, I

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

07/03/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/243,016

Applicant(s)

Lenz et al.

Examiner

Isis Ghall

Group Art Unit

1615



☒ Responsive to communication(s) filed on Jun 12, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 13 is/are allowed.

☒ Claim(s) 1-12 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

The receipt is acknowledged of applicants request for extension of time, change of firm name and amendment B, all filed 5/30/2000; and change of telephone number, filed 6/12/2000.

Claims 1-13 are pending in the application and the status of the claims are as follows:

#### ***Claim Rejections - 35 USC § 103***

1. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riedel et al. US 4,793,003 ('003), in view Kenndoff et al. US 5,844,013 ('013), further in view of Martz WO 89/01345 (WO '345) and Kohn et al. US 4,709,695 ('695). The rejection was addressed in details in the previous office action dated 1/12/2000 in paper No. 5 and is maintained for reasons of records.

#### ***Response to Arguments***

2. Applicant's arguments filed 5/30/2000 have been fully considered but they are not persuasive.

Applicants traverse the rejection by arguing that '003 teaches a porous film not a foam film and its thickness is much thinner than the applicant's film.

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It is the position of the examiner that the foam layer is made from the same material as the porous film and no particular size of the cells of the foam was claimed. Logically, the porous film of polyurethane will function as a foam layer. It is within the gambit of the skilled artisan to adjust the thickness and density of the film layer to achieve a beneficial effect. Therefore, the thickness of the film instantly claimed is not critical absent evidence showing unexpected and superior results.

Applicants argue that US '013 and WO '345 are not disclosing eye patch and their combination with US '003 and US '695 will not lead those skilled in the art to applicant's light occlusive eye patch..

It is the position of the examiner that the claims are drawn to a product and the preamble does not carry any patentable weight. All the layers and materials are disclosed by the patents in combination, and the future intended use has no patentable significance in product claims. The burden is shifted to the applicants to show why the claimed patch is distinguishable from the other disclosed patches. A conclusion of obviousness under 103(a) does not require absolute predictability, only a reasonable expectation of success; and the references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *See In re Bozek*, 163 USPQ 545 (CCPA 1969).

Accordingly, it would have been obvious for one with ordinary skill in the art at the time of the invention to combine all the said forth teachings to produce an occlusive plaster consisting of at least one layer of foam material which is provided with adhesive on its lower layer with

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reasonable expectation of success of the delivered occlusive plaster. While Riedel been concerned about the thickness and softness of the eye patches and of making them comfortable to wear, one with ordinary skill in the art would have been motivated to produce a patch from foam material.

*Conclusion*

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Claims 1-12 are rejected.
5. Claim 13 is allowed.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Isis Ghali whose telephone number is (703) 305-4048. The examiner can normally be reached on Monday-Friday from 8:30 to 5:30 Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner Isis Ghali,

June 27, 2000.

  
THURMAN PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600